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In re PATENT APPLICATION of:
Edward McNulty
Application No.: 10/645,574
Filed: August 22, 2003
For: Head Cover Trimming System

DECISION ON PETITION

This is a decision on the petition filed on May 23, 2005 by which Petitioner requests reconsideration and withdrawal of the restriction requirement rendered in the Office action mailed on December 29, 2004 and made final in the Office action dated March 24, 2005. The petition is considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is granted-in-part.

A review of the record shows that a restriction requirement was made on December 29, 2004 requiring Petitioner to limit the prosecution of this case to a single invention among four groupings of claims as follows:

- I. Claim 1, drawn to the combination of a head cover trimming system with a head cap and a cutting head system, classifiable in class 30, subclass 500.
- II. Claims 2-13, drawn to the subcombination of a cutting head system, classifiable in class 30, subclass 347.
- III. Claims 14-19, drawn to the subcombination of a head cap, classifiable in class 239, subclass 201.
- IV. Claims 20 and 21, drawn to the method of trimming around a ground level head cover, classifiable in class 83, subclass 13.

Petitioner responded in a communication dated January 25, 2005 electing the group II invention for examination. From that point in the prosecution to date, Petitioner has cancelled claims 6, 20 and 21; amended claim 10 to be in independent form; and added new claims 22 and 23 drawn to the subcombination cutting head system, which would be categorized with the group II claims above. Claims 2-5 and 7-13 have been amended and found allowable. Claims 22 and 23 have been indicated allowable.

The undersigned will address then propriety of the restriction requirement with respect to the currently pending claims.

Petitioner is traversing the requirement on the grounds that the subcombinations of groups II and III are not distinct from the combination of group I, and that the method of group IV would not impose any further burden if examined with the remaining claims.

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent or distinct as claimed; and
- (B) There would be a serious burden on the Examiner if restriction were not required.

First consideration will be given for the inventions that fall within different categories of inventions, i.e., the method of group IV and the apparatus of groups I-III. In accordance with the MPEP 806.05 (e), distinctness between these claimed inventions does exist since the method can be performed by apparatus materially different than that set forth in the apparatus claims of groups I – III. The undersigned believes that Petitioner would agree with such distinctness especially in light of his response to the restriction dated January 25, 2005, page 3, third full paragraph. Since Petitioner cancelled claims 20 and 21, in order to preserve Petitioners rights in filing a divisional application under 35 U.S.C. 121, the restriction requirement between the method and apparatus groupings must stand. However, since this case is not under final rejection and claims 20 and 21 have been cancelled, Petitioner's attention is directed to the MPEP sections 821.04 – 821.04 (b) providing guidelines for rejoinder of non-elected claims with elected claims. Otherwise, the restriction between groups I – III and group IV is moot.

Considering the distinctness between the combination of the group I claims and the subcombinations of the groups II and III claims, such related inventions are distinct if the inventions as claimed are not connected in at least one design, operation, or effect, AND wherein at least one invention is patentable over the other. See MPEP section 802.02. Each of the parts of this invention as claimed are connected by design, but have different operations. The cutting head system trims around the head cover of the sprinkler system, while the head cap protects the head cover and centers the cutting head over the head cover. For further guidance in showing distinctness, the criteria set forth in the MPEP section 806.05 (c) states that,

“Inventions are distinct if it can be shown that a combination as claimed:

- (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in another materially different combination.”

Considering the distinctness between the subcombination groups II and III claims, the MPEP section 806.05(d) provides guidance for determining distinctness between

subcombinations disclosed as usable together in a single combination. "The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable." The meaning of "not overlapping in scope" can be found in the MPEP section 806.04(f). In other words, if one claim recites limitations disclosed for a first subcombination, but not a second subcombination, while a second claim recites limitations disclosed only for the second subcombination, but not the first subcombination, such claims do not overlap in scope. Comparing claims 2, 10 and 22 of the group II claims to claim 14 of the group III claims, clearly, they "do not overlap in scope and the differences are not obvious variants. The last element of distinctness to show is if at least one of the subcombinations is separately usable, not from each other, but from the disclosed combination. Referring to figures 2 and 3, the head cap is nothing more than a conically shaped plate with a central hole therethrough, which could be used for many different other purposes such as a cover for a container, a stand for a pole such as a small flag pole, a candle stick holder, etc. Petitioner appears to be in agreement with this as is evident from his remarks on page 2, second full paragraph of the petition. Also, the claimed subject matter of each subcombination is so diverse such that the search and examination for each would result in divergent fields of search would be considered a burden on the examiner.

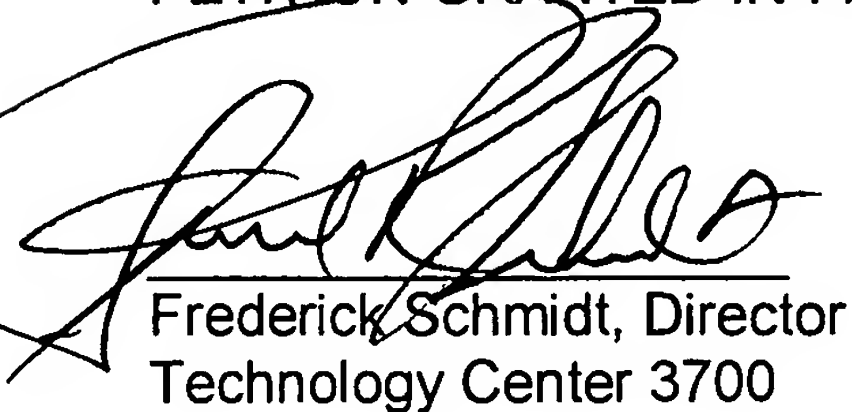
At this point in the prosecution of this case, Petitioner has amended combination claim 1 of group I to include the allowable subject matter of subcombination claim 2 of group II, which renders claim 1 allowable. Referring again to the criteria (A) above for showing distinctness between a combination/subcombination relationship, distinctness between groups I and II no longer exist since the patentability of the combination as claimed in claim 1 requires the particulars of the subcombination as claimed in claim 2 for patentability. Distinctness between groups I and III does exist, i.e., that the particulars of the subcombination as claimed of group III is not required in the combination as claimed in group I for patentability as evidenced by the allowability of the subcombination of Group II. Furthermore, the search and examination of the group III claims would be divergent from the search and examination of the group I claim which would constitute a burden on the examiner. Thus, the restriction requirement between groups I and III remains proper.

To summarize:

- 1) the restriction requirement between the apparatus claims 1-5, 7-19, 22 and 23 of groups I-III and cancelled method claims 20 and 21 of group IV (should Petitioner decide to rejoin these claims) stands;
- 2) the restriction requirement between group I (combination claim 1), and group II (subcombination claims 2-5, 7-13, 22 and 23) is hereby withdrawn; and
- 3) the restriction requirement between group I (combination claim 1) and group III (subcombination claims 14-19) stands.

For the reasons outlined above, Petitioner is granted partial relief from the restriction requirement. The amendment presented September 30, 2005 is deemed responsive to which a new Office action will be rendered. The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3724 who will have the examiner promulgate an action on the merits of the presently pending claims not inconsistent with this decision.

PETITION GRANTED-IN-PART



Frederick Schmidt, Director
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Date: July 13, 2006
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